

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SCHWEIGHOFFER et al. Atty. Ref.: 3665-167; Confirmation No. 5165

Appl. No. 10/560,774 TC/A.U. 1617

Filed: December 14, 2005 Examiner: Javanmard

For: USE OF PYRAZOLOPYRIDINES FOR THE TREATMENT OF COGNITIVE DEFICITS

* * * * *

July 23, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST TO WITHDRAW THE FINALITY OF THE OFFICE ACTION DATED JUNE 24, 2008 AS BEING PREMATURE PURSUANT TO MPEP § 706.07(a) AND FOR RE-MAILING OF NEW, NON-FINAL ACTION WITH DATE FOR RESPONSE RE-SET FROM MAILING OF NEW NON-FINAL OFFICE ACTION

The Examiner is requested to withdraw the finality of the Office Action dated June 24, 2008 and re-mail a new, non-final Office Action with the date for response re-set from mailing of new, non-final office action, as the finality of the Office Action dated is submitted to be premature and contrary to the MPEP § 706.07(a).

Specifically, the undersigned notes that an Amendment filed March 10, 2008 in response to the non-final Office Action of November 30, 2007 revised independent claim 7 to include the details of dependent claims 8 and 9 and claims 8 and 9 were canceled, without prejudice.

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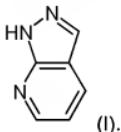
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REQUEST TO WITHDRAW THE FINALITY OF THE OFFICE ACTION DATED JUNE 24, 2008 AS BEING PREMATURE PURSUANT TO MPEP § 706.07(a) AND FOR RE-MAILING OF NEW, NON-FINAL ACTION WITH DATE FOR RESPONSE RE-SET FROM MAILING OF NEW NON-FINAL OFFICE ACTION

Claims 7, 8 and 9 pending prior to the non-final Office Action of November 30, 2007 are reproduced below:

7. A method of treating cognitive deficits in a patient having a neurodegenerative disease, the method comprising administering to the patient an effective amount of a compound of the pyrazolopyridine family.

8. The method of claim 7, wherein the compound is a substituted or substituted compound of formula (I)



9. The method of claim 8, wherein the compound is etazolate or tracazolate.

Claim 7 was revised in an Amendment filed March 10, 2008 to read as follows in response to the non-final Office Action of November 30, 2007 (wherein underlined text is to be added and strike-through text is to be deleted):

7. A method of treating cognitive deficits in a patient in need thereof ~~having a neurodegenerative disease~~, the method comprising administering to the patient an effective amount of etazolate ~~a compound of the pyrazolopyridine family~~.

The non-final Office Action of November 30, 2007 contained a single art rejection of claims 7-12, i.e., a Section 102 rejection over Barndad (WO 01/78709). This Section 102 rejection of claims 7-12 was withdrawn in the final Office Action of June 24, 2008 in response to the Amendment and Remarks of March 10, 2008.

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The final rejection of June 24, 2008 includes a new rejection art rejection of claims 7, 11 and 12 over newly cited art, which is submitted to be contrary to MPEP § 706.07(a). Consideration of the following in this regard and a new non-final Office Action with the date for responding being re-set from the mailing of the new Action are requested.

MPEP § 706.07(a) provides as follows (see www.uspto.gov (July 23, 2008) emphasis added):

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. **>However, note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph)<.

The final rejection of June 24, 2008 includes a new rejection of claims 7, 11 and 12 over Ikhlef (U.S. Patent Application Publication No. 2003/0064374) and Dalton (WO 98/11887). See pages 3-4 of the Office Action dated June 24, 2008. Dalton is newly cited by the Examiner and was not previously of record. Moreover, while Ikhlef was record, the document was not cited against any of claims 7-12 in the non-final Office Action of November 30, 2007.

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As noted above, the Amendment of March 10, 2007 revised independent claim 7 to include details of dependent claims 8 and 9. The amendment should reasonably have been expected and, in effect, the Examiner is now rejecting the subject matter of previously-pending claim 9 over new art (Ikhlef and Dalton or a rejection including the newly cited Dalton) in a final rejection. The Examiner's final rejection of June 24, 2008 is submitted to be premature and contrary to the above-quoted passage of MPEP § 706.07(a).

Withdrawal of the final rejection of June 24, 2008 is requested. The Office is requested to mail a new non-final Office Action or Notice of Allowance with the date for responding being re-set from the mailing date of the new Action or Notice.

The finality of the Office Action dated June 24, 2008 is submitted to be premature and contrary to the MPEP, as explained in MPEP § 706.07(a), for example. Withdrawal of the finality of the Office Action and re-mailing of a new, non-final Office Action, with the date for response being re-set from the mailing of the new Action, are requested.

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Respectfully submitted,

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